



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,148	08/27/2001	Michael Zobel	Mo-6485/LeA33,061	7822

157 7590 03/29/2006

BAYER MATERIAL SCIENCE LLC
100 BAYER ROAD
PITTSBURGH, PA 15205

EXAMINER

GULAKOWSKI, RANDY P

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,148

Applicant(s)

ZOBEL ET AL.

Examiner

Jeffrey B. Robertson

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5,7-9,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5,7-9,12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 2, 3, 5, 8, 9, 12, and 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, 13, and 15 of U.S. Patent No. 6,444,735. Although the conflicting claims are not identical, they are not patentably distinct from each other because even though the '735 patent requires a mixture of two aromatic polycarbonates and the presence of additional components D and E, the present claims encompass the claims of the '735 patent. Note that AIO(OH) is claimed in claim 1 of the '735 patent. In addition, the amounts claimed in the instant application and the patent significantly overlap.

Art Unit: 1712

3. Claims 2, 3, 5, 7-9, 12, and 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 9-13 of U.S. Patent No. 6,569,930. Although the conflicting claims are not identical, they are not patentably distinct from each other because even though the '930 patent contains components not claimed in the instant application, the use of the term "comprising" in the instant claims allows for the presence of these other components. The instant claims encompass the claims of the '930 patent. In addition, the amounts claimed in the instant application and the patent significantly overlap.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 2, 3, 5, 7-9, 12, and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 99/07791 (as evidenced by Eckel et al. U.S. Patent No. 6,444,735).

WO 99/07791 and Eckel are believed to be equivalents. Therefore, the following rejection refers to the Eckel patent. In addition, Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Eckel sets forth a composition including aromatic polycarbonates, a vinyl copolymer, a graft polymer, and a finely divided inorganic compound with a particle size less than or equal to 200 nm used for molding materials. Col. 1, line 55 through col. 2,

line 47. In col. 10, line 38, Eckel sets forth $\text{AlO}(\text{OH})$ as the inorganic material. For claim 7, in col. 6, lines 24-34, Eckel teaches graft polymers that are prepared from styrene and acrylonitrile monomers in the amounts required by applicant. For claims 8 and 9, Eckel sets forth inorganic compounds and additives in col. 11, lines 5-22.

6. Claims 2, 3, 5, 7-9, 12, and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 99/07782 (as evidenced by Eckel et al. U.S. Patent No. 6,569,930).

WO 99/07782 and Eckel are believed to be equivalents. Therefore, the following rejection refers to the Eckel patent. In addition, Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Eckel sets forth a composition including aromatic polycarbonates, a vinyl copolymer, a graft polymer, and a finely divided inorganic compound with a particle size less than or equal to 200 nm used for molding materials. Col. 2, line 27 through col. 3, line 10. In col. 10, line 6, Eckel sets forth $\text{AlO}(\text{OH})$ as the inorganic material. For claim 7, in col. 6, lines 4-20, Eckel teaches graft polymers that are prepared from styrene and acrylonitrile monomers in the amounts required by applicant. For claims 8 and 9, Eckel sets forth inorganic compounds and additives in col. 10, lines 36-58.

Response to Arguments

7. Applicant's arguments filed 2/28/06 have been fully considered but they are not persuasive. First, it is noted that the arguments set forth by applicant are largely moot due to the new grounds of rejection set forth in this office action. Second, the Eckel

Art Unit: 1712

declaration submitted by Applicant is not persuasive. Specifically, the aluminum oxide on silica used in the comparative example has particle sizes much larger than those set forth in the Pan reference and the sizes claimed in the present application. Therefore, the results of the declaration are not commensurate in scope with the present claims or consistent with the closest prior art teachings.

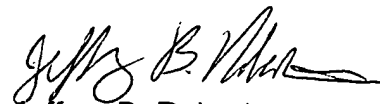
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JBR


Jeffrey B. Robertson
Primary Examiner
Art Unit 1712